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PATENT
ATTORNEY DOCKET NO. 00654759

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	Group Art Unit:
Maor, et al.)	1617
)	Examiner:
Serial No.: 09/582,522)	Wells, L.
)	
Filing Date: April 10, 2000)	
)	
For: A GEL COMPOSITION FOR)	
SKIN CARE AND PROTECTION))	
AND A METHOD OF)	
PREPARATION THEREOF)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO FINAL OFFICE ACTION OF APRIL 7, 2004

Dear Sir:

This Response is being filed in response to the Final Office Action mailed April 7, 2004 in the above referenced application.

The undersigned thanks the Examiner for her time and patience during the teleconference of June 28, 2004. The prior art of Kyotaro, Biener and Thompson was discussed. Applicants communicated their belief that none of the cited art disclosed any motivation to look to the use of non-ionic solubilizers to cause transparency in a gel formulation including Dead Sea water and a hydrophobic active agent. Moreover, Applicants asserted that such results were unexpected. The Examiner indicated that a Declaration referencing the unexpected nature of the results and further distinguishing the closest art of record might further the prosecution of this application. It was agreed that Applicants should submit such a Declaration, and that further correspondence

with the Office would indicate whether further amendments to the claims might be necessary in light of the Declaration.

Accordingly, Applicants submit the Declaration of co-inventor, Shlomo Magdassi.

The Declaration explains the following important considerations. First, the most relevant art relied upon by the Examiner, Kyotaro, does not disclose a gel composition, nor how one would make a transparent gel composition, having both Dead Sea water and hydrophobic active agents. (Declaration, ¶ 5).

Second, the secondary reference, Biener, fails to disclose actual Dead Sea water (teaching away from such a component) and does not discuss hydrophobic active agents. (*Id.*, ¶ 6). Thus, the problem of creating a clear gel comprising *both* Dead Sea water and hydrophobic active agents was not envisioned by Biener.

Third, all of the prior art attempts to combine Dead Sea water and hydrophobic active agents into a gel led to a cloudy, or murky, gel. The various reasons for this phenomenon are believed to be various chemical reactions caused by the high electrolyte content of Dead Sea water, or other causes. (*Id.*, ¶ 8). Such cloudy gels were not aesthetically pleasing, and therefore insufficient for the desired purpose of providing an aesthetically pleasing gel combining the therapeutic effects of Dead Sea water and hydrophobic active agents.

Various attempts were made to combine Dead Sea water and hydrophobic active agents to produce a transparent gel. Those attempts are described in the accompanying Declaration and led to the surprising result that the addition of non-ionic solubilizers would produce a clear gel. (*Id.*, ¶¶ 9-13).

Although non-ionic solubilizers are known cosmetic additives (*see* Thompson), there is no teaching or motivation that adding them to a combination of Dead Sea water and hydrophobic active agents would produce transparency. (*Id.*, ¶ 14). This motivation must be present in the prior art, and must be specifically set forth to avoid the use of hindsight to arrive at an invention. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (the motivation to combine reference must be “clearly and particularly” taught in the references). Thus, Thompson, which did not discuss Dead Sea water or the problem of a cloudy gel would not have provided the source for a teaching to arrive at a clear gel.

In essence, the Examiner has provided a group of references that *individually* disclose each of the components of the present invention. However, Applicants respectfully submit that none of those reference, nor any general knowledge of one skilled in the art, teaches the present *combination*. It is not enough simply to find each of the individual components in the prior art – if it were, no claims to novel compositions would ever issue. Here, the particular motivation is lacking, and the claims are thus each patentable over Kyotaro, Biener and Thompson.

The Commissioner is hereby authorized to charge any additional fees (or credit any overpayment) associated with this communication to our Deposit Account No. 13-0019. If a fee

is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such extension is requested and such fee should also be charged to our Deposit Account.

MAYER, BROWN, ROWE & MAW LLP Respectfully submitted,
P.O. Box 2828
Chicago, Illinois 60690-2828
312-701-8773

A handwritten signature in black ink, appearing to read 'D. Shulman', is written over a horizontal line.

Daniel H. Shulman
Attorney for Applicant
Reg. No. 45,106

Dated: July 6, 2004



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~~Timothy Hubalik~~ Rebecca Castro
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Rebecca Castro
(signature of person mailing paper or fee)

TRANSMITTAL LETTER

Dear Sir:

Enclosed for filing please find:

1. Response to Final Office Action of April 7, 2004;
2. Declaration #2 Under 37 C.F.R. § 1.132 of Shlomo Magdassi;
3. Return postcard.

If there are any additional fees due in connection with the filing of this response, please charge these additional fees (or credit any overpayment) associated with this communication to our Deposit Account No. 13-0019.

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Respectfully submitted,

Daniel H. Shulman
Reg. No. 45, 106
Attorney for Applicant

Dated: July 6, 2004